

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Atty. Ref: 36-1008

ATTWATER et al.

Serial No. 09/930,395 (Reissue of U.S. Patent No. 5,940,793)

Filed: August 16, 2001

For: VOICE-OPERATED SERVICES

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Hon. Commissioner of Patents  
and Trademarks  
Washington, DC 20231

Sir:

COMBINED REISSUE DECLARATION AND POWER OF ATTORNEY

1. The undersigned inventors, David J. Attwater, Steven J. Whittaker, Francis J. Scahill and Alison D. Simons (hereinafter "Applicants") hereby declare that for each of them his/her residence, post office address and citizenship are as stated below next to his/her respective name and each believes that Applicants are the original, first and joint inventors of the invention entitled VOICE-OPERATED SERVICES described and claimed in the attached reissue specification filed as U.S. Application No. 09/930,395 on August 16, 2001 and also described and claimed in their original application, U.S. Application No. 08/817,673 filed April 21, 1997 as a national phase filing under 35 U.S.C. §371 of international application no. PCT/GB95/02524 filed October 25, 1995, and the resulting original U.S. Patent No. 5,940,793 (hereinafter "the '793 patent") which issued August 17, 1999; for which priority under 35 U.S.C. §119 was claimed based on European Patent

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Application No. 94307843 filed on October 25, 1994; and for which invention a reissue patent is solicited; that they have each reviewed and understand the contents of the attached reissue specification filed as U.S. Application No. 09/930,395, including the claims (i.e., claims 1-49) as amended and added by any amendment(s) specifically referred to in this Declaration; and that each acknowledges the duty to disclose information of which they are aware and which is material to the examination of the application in accordance with 37 CFR §1.56(a).

On information and belief, each of the inventors does not know and does not believe that this invention was ever known or used in the United States before Applicants' invention thereof, or patented or described in any publication in any country before Applicants' invention thereof, or more than one year prior to the original application, or in public use or on sale in the United States more than one year prior to the original application; that this invention had not been patented or made the subject of an inventor's certificate in any country foreign to the United States prior to the date of the original application on an application filed by the inventors or their legal representative or Assignee more than 12 months before their original application.

2. Each of Applicants, believes that, through error, the original '793 patent is wholly or partly inoperative as a legal document by reason of (i) Applicants claiming more or less than they had a right to claim in the patent, and (ii) Applicants' inadvertent failure to disclose possibly pertinent references. All errors being corrected in this reissue application up to the time of filing this Declaration arose without any deceptive intention on the part of Applicants.

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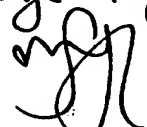
3. One error relied upon as a basis for this reissue application is Applicants' failure to request a scope of coverage such as the claims accompanying this reissue application which are necessary to adequately protect Applicants' invention. This error in claiming more or less than Applicants had a right to claim in the '793 patent occurred due to an inadvertent lack of appreciation of the availability of the scope of protection as defined by the amended and additional claims presented with this reissue application.

To correct this error, this reissue application seeks to amend certain of the original claims of the '793 patent and add additional claims. Specifically, claim 16 has been canceled and claims 17 and 18, each depending from claim 16 in the original '793 patent, have been rewritten in independent form. Independent claims 12 and 15 have been amended to delete the recitation of "or destination." Newly added reissue claims 38-45 require, inter alia, indicating the destination of a telephone call but do not require indicating the origin of a telephone call. Newly added independent reissue claims 46 and 48 are directed to a method and apparatus which require, inter alia, accessing stored information identifying a subset of a set of utterances and restricting recognizing operation to that subset responsive to receipt of signals indicating the origin of spoken words. Unlike claim 12, claims 46 and 48 do not require spoken words received via a telephone line connection. Newly added independent reissue claims 47 and 49 require, inter alia, accessing stored information identifying a subset of a set of speakers and restricting recognizing operation to that subset responsive to receipt of signals indicating the origin of spoken words. Unlike claim 12, claims 47 and 49 do not require spoken words being received via a telephone line connection.

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4. A further error relied upon as a basis for this reissue application is Applicants' inadvertent failure to properly disclose possibly pertinent references (hereinafter "the REFERENCES") during the prosecution of U.S. Application Serial No. 08/817,673 (hereinafter "the U.S. '673 application") resulting in the U.S. '793 patent. The REFERENCES are hereby identified as follows:

U.S. PATENT DOCUMENTS		
<i>Document No.</i>	<i>Date</i>	<i>Name</i>
4,763,278	08/1988	RAJASEKARAN et al.
5,355,474	10/1994	THURAISNGHAM et al.
4,701,879	10/1987	SCARR
FOREIGN PATENT DOCUMENTS		
<i>Document No.</i>	<i>Date</i>	<i>Country</i>
0 601 710 A2	06/1994	Europe
0 484 070 A2	05/1992	Europe
0 533 338 A2	03/1993	Europe
6-204952	07/1994	Japan
2,091,658	09/1994	Canada
WO 93/05605	03/1993	PCT
OTHER DOCUMENTS		
K.E. Niebuhr et al., "N Ary Join for Processing Query by Example November 1976", IBM TECHNICAL DISCLOSURE BULLETIN, vol. 19, no. 6, November 1976, pages 2377-2381, XP002081147 New York, US		

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Each of the REFERENCES is listed on the Form PTO-1449 filed concurrently with the filing of this reissue application. A copy of each of the REFERENCES was also filed concurrently with the Form PTO-1449.

The Form PTO-1449 also lists U.S. Patent No. 5,475,792 (Stanford et al) which is a U.S. counterpart to Canada Patent No. 2,091,658 and U.S. Patent No. 5,479,488 (Lennig et al) which is a U.S. counterpart to Japan document no. 6-204952. Copies of U.S. Patent Nos. 5,475,792 and 5,479,488 were concurrently filed with the Form PTO-1449.

U.S. Application No. 08/817,673 (hereinafter the "U.S. '673 application") is a national phase filing under 35 U.S.C. §371 of international application no. PCT/GB95/02524 (hereinafter the "PCT '524 application") and claims foreign priority based on European patent application no. 94307843 (hereinafter the "EP '843 application"). On information and belief, the EP '843 application was written by Barry Lloyd, one of Applicants' in-house patent attorneys working in the Intellectual Property Department of Assignee. The PCT '524 application was co-written by Barry Lloyd and Juliet Hibbert, who was at that time another in-house patent attorney working in the Intellectual Property Department of Assignee. The PCT '524 application includes essentially all of the disclosure of the EP '743 application plus additional disclosure. During prosecution of the PCT '524 application, an International Search Report dated May 31, 1996 was issued by the International Search Authority. On information and belief, Juliet Hibbert reviewed the International Search Report and became aware of the references cited therein.

Other national phase applications from the PCT '524 application were filed including European patent application no. 95934749 (hereinafter the "EP '749 application") filed in February 26, 1997, and New Zealand application no. 294296 (hereinafter the "NZ

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'296 application") filed February 26, 1997. On information and belief, Juliet Hibbert had the responsibility of filing (or at least working with retained outside counsel to file) these national phase applications on behalf of Assignee.

Assignee received a non-unity objection dated December 9, 1997 from the European Patent Office during the prosecution of the EP '749 application. On information and belief, Ms. Hibbert requested payment of the necessary fees for additional searches for separate inventions in response to the objection. Assignee also received an Office Action dated August 7, 1997 from the New Zealand Patent Office during the prosecution of the NZ '296 application.

On information and belief, Ms. Hibbert ended her employment with Assignee on or about February 13, 1998. At or about that same time, Alison D. Simons, one of the named joint inventors of the invention, took over responsibility of prosecuting the U.S. '673, EP '749 and NZ '296 applications on behalf of Assignee in her capacity as a trainee in Assignee's Intellectual Property Department under the supervision of Bob Semos, an in house patent attorney working in the same department. Specifically, Mrs. Simons took over the responsibility of working with Assignee's retained outside U.S. counsel (i.e., the attorneys of record) on the prosecution of the U.S. '673 application on behalf of Assignee under the supervision of Mr. Semos and took over the responsibility of working with Assignee's retained outside New Zealand counsel on the prosecution of the NZ '296 application under the supervision of Bob Semos.

An Official Action dated September 2, 1998 was issued from the U.S. Patent Office for the U.S. '673 application. After reviewing the U.S. '673 application, the September 2 U.S. Official Action, cited prior art and a letter dated September 9, 1998 from retained outside

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U.S. counsel, Mrs. Simons wrote a letter dated February 19, 1999 containing a response strategy to the September 2 Official Action. An Amendment dated March 2, 1999 was filed in the U.S. Patent Office by outside U.S. counsel on the basis of this strategy. A Notice of Allowance dated March 25, 1999 was issued in response to the Amendment and was reported to Mrs. Simons in a letter from outside U.S. counsel dated March 31, 1999. The U.S. '673 application issued as the U.S. '793 patent on August 17, 1999. The references cited in the International Search Report in the PCT '524 application were cited during the prosecution of the U.S. '673 application.

In response to Ms. Hibbert's requested payment for the necessary fees for additional searches for separate inventions, a Supplementary Search Report dated October 22, 1998 was issued by the European Patent Office in the EP '749 application. The Supplementary Search Report cites all of the references previously cited on the International Search Report plus additional references (hereinafter the "newly cited references"). The Supplementary Search Report was received by Assignee on November 2, 1998 (i.e., before the issuance of the U.S. '793 patent).

An Official Action dated June 4, 1999 was issued from the European Patent Office for the EP '749 application. After reviewing the EP '749 application, the June 4 European Official Action and the International and Supplemental Search reports, Mrs. Simons prepared a response to the European Official Action and filed the same on March 9, 2000. In the March 9 response, those claims which were objected to as not complying with the European Patent Office's unity of invention provisions were canceled. On information and belief, Mrs. Simons did not study in detail the newly cited references of the Supplemental Search Report since those references were cited as being possibly pertinent to claims that

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were canceled in the response. The European Patent Office issued a notice under Rule 51(4) of the European Patent Convention (similar to a Notice of Allowance in U.S. practice) on March 20, 2001. In an email dated March 29, 2001 Mrs. Simons reported the notice to David Attwater, another named inventor, and commented on the possibility of filing a divisional application in the European Patent Office for some of those claims canceled during the prosecution of the EP '749 application.

After reviewing the NZ '296 application, the August 7, 1997 New Zealand Official Action and cited references including document WO 93/05605 (hereinafter "WO '605" in or around February 3, 1999 (i.e., before the issuance of the U.S. '793 patent), Mrs. Simons wrote a letter containing a response strategy to Assignee's retained outside New Zealand counsel. A response dated February 4, 1999 was filed in the New Zealand Patent Office by outside New Zealand counsel on the basis on this strategy. On information and belief, WO '605 was cited in the August 7, 1997 New Zealand Office Action as being possibly pertinent to a claim which was deleted in the February 4, 1999 response. The NZ '296 application issued as New Zealand Patent No. 294296 on August 11, 1999. Based on Mrs. Simon's instruction, outside New Zealand counsel filed New Zealand divisional patent application no. 334083 (hereinafter the "NZ '083 application") on February 5, 1999. After receiving and reviewing a non-unity objection dated February 11, 1999 issued by the New Zealand Patent Office in the NZ '083 application, Mrs. Simons instructed retained outside New Zealand counsel to cancel the claim to which WO '605 was cited as being possibly pertinent. The NZ '083 application issued as New Zealand Patent No. 334083 on January 11, 2001.

To the best of Applicants' information and belief, Mrs. Simons was therefore aware of the newly cited references of the Supplemental Search Report issued in the prosecution

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of the EP '749 application and WO '605 cited in the prosecution of the NZ '296 application at some point during the pendency of the U.S. '673 application. To the best of Applicants' information and belief, Mrs. Simons was not acutely aware of or did not fully appreciate at that time the duty to disclose known prior art to the U.S. Patent Office and thus did not inform retained outside U.S. counsel about the newly cited references of the Supplemental Search Report or WO '605 during the pendency of the U.S. '673 application. The newly cited references and WO '605 were therefore not provided to the U.S. Patent Office during the pendency of the U.S. '673 application.

On information and belief, Mrs. Simons ended her employment with Assignee on or around April, 2001. Barry Lloyd, an in-house patent attorney in Assignee's Intellectual Property Department, took over the prosecution of the EP '749 application. At the time Mrs. Simons ended her employment with Assignee, the prosecution of the U.S. '673 application had ended (i.e., the U.S. '793 patent and New Zealand Patent Nos. 294296 and 334083 issued prior to Mrs. Simons ending her employment with Assignee).

On information and belief, after reviewing the notice under rule 51(4) of the European Patent Convention, Mr. Lloyd reviewed Assignee's file containing documentation relating to the EP '749 application. During his review of the file, Mr. Lloyd became aware of the existence of the Supplemental Search Report from the European Patent Office and the newly cited references listed therein.

On information and belief, after reviewing the Supplemental Search Report and newly cited references in detail, Mr. Lloyd realized that the newly cited references may be pertinent to claims that were canceled during the prosecution of the EP '749 application and which might form the subject of a European divisional application. Mr. Lloyd then

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obtained and reviewed the file containing documentation relating to the U.S. '673 application and determined that the Supplemental Search Report and the newly cited references were not provided to outside U.S. counsel and hence not filed in the U.S. Patent Office during the prosecution of the U.S. '673 application.

On information and belief, Mr. Lloyd discussed the existence of the Supplemental Search Report and the newly cited references in early August, 2001 with Alison Simons who was then and is currently a British patent attorney working in private practice. Mr. Lloyd also discussed the existence of the Supplemental Search Report and the newly cited references with Bob Semos in a separate conversation. On information and belief, Mr. Semos informed Mr. Lloyd that he had no recollection of the prosecution of the U.S. '673 application. After discussing the matter, Mrs. Simons, Mr. Semos and Mr. Lloyd each concluded that the failure to disclose the newly cited references to the U.S. Patent Office during prosecution of the U.S. '673 application was an inadvertent error.

On information and belief, soon after or about the same time as discussing the existence of the Supplemental Search Report and the newly cited references with Alison Simons and Bob Semos, Mr. Lloyd obtained the file containing documentation relating to the NZ '296 and NZ '083 applications. Upon reviewing the contents of these files, Mr. Lloyd first became aware of the existence of WO '605. Mr. Lloyd discussed the existence of WO '605 with Alison Simons and Bob Semos in separate conversations. Mrs. Simons, Mr. Semos and Mr. Lloyd each concluded that the failure to disclose WO '605 to the U.S. Patent Office during the prosecution of the U.S. '673 application was an inadvertent error.

5. The Applicants now seeks to correct the errors noted in ¶¶3 and 4 above by requesting that the '793 patent be reissued. Accordingly, Applicants have filed the instant

reissue application in order to properly claim what they have a right to claim and to properly disclose the REFERENCES inadvertently not disclosed during prosecution of the '673 application.

Applicants hereby appoint Nixon & Vanderhye, P.C., 1100 North Glebe Road, 8th Floor, Arlington, Virginia 22201-4714, telephone number (703) 8164000, facsimile number (703) 816-4100, and the following attorneys thereof: Arthur R. Crawford, 25327; Larry S. Nixon, 25640; James T. Hosmer, 30184; Robert W. Faris, 31352; Richard G. Besha, 22770; Mark E. Nusbaum, 32348; Michael J. Keenan, 32106; Bryan H. Davidson, 30251; Stanley C. Spooner, 27393; Leonard C. Mitchard, 29009; Duane M. Byers, 33363; Jeffry H. Nelson, 30481; John R. Lastova, 33149; H. Warren Burnam, Jr. 29366; Thomas E. Byrne, 32205; Mary J. Wilson, 32955; J. Scott Davidson, 33489; Alan M. Kagen, 36178; Robert A. Molan, 29834; B. J. Sadoff, 36663; James D. Berquist, 34776; Updeep S. Gill, 37334; Michael J. Shea, 34725; Donald L. Jackson, 41090; Michelle N. Lester, 32331; Frank P. Presta, 19828; Joseph S. Presta, 35329; Joseph A. Rhoa, 37515; Raymond Y. Mah, 41426; Chris Comuntzis, 31,097 as my attorneys in the above-entitled application, to prosecute this application, to make alterations and amendments therein, and to transact all business in the Patent and Trademark Office connected therewith.

All correspondence regarding the above-identified application is to be sent to:

**NIXON & VANDERHYE P.C.**  
1100 North Glebe Road, 8th Floor  
Arlington, Virginia 22201-4714

The telephone number is (703) 816-4000.

Applicants hereby declare further that all statements made herein of their own knowledge are true and that all statements made on information and belief are believed to

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[Signature]

be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Name: David J. Attwater

Signature: \_\_\_\_\_

Citizenship: British

Post Office Address: 7 Willoughby Road  
Ipswich, Suffolk IP2 8AP  
Great Britain

Date: \_\_\_\_\_

31/01/02

Signed by David J. Attwater  
in my presence this 31st day  
of January 2002

S.M.J. LEACH  
19 CHURCH STREET  
WOODBIDGE, SUFFOLK

Notary Public

Name: Steven J. Whittaker

Signature: \_\_\_\_\_

Citizenship: British

Post Office Address: 5012 De Quincey Drive  
Fairfax, Va. 22032  
U.S.A.

Date: \_\_\_\_\_

Name: Francis J. Scahill

Signature: *Francis J. Scahill*

Date: 31/01/02

Citizenship: British

Post Office Address: Leather Bottle Cottage,  
Little Blakenham  
Ipswich, Suffolk IP8 4 NG  
Great Britain

*Signed by FRANCIS JAMES  
SCAHILL in my presence  
this 31st day of January  
2002*

*S.M.J. LEACH*  
19 CHURCH STREET  
WOODBIDGE, SUFFOLK

Notary Public

Name: Alison D. Simons

Signature: *Alison D. Simons*

Date: 31/01/02

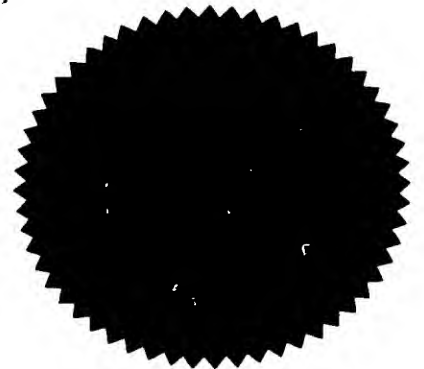
Citizenship: British

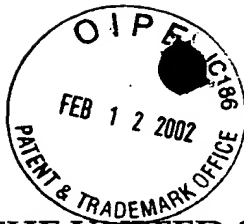
Post Office Address: The Postern, Marcus Road  
Felixstowe, Suffolk IP11 7NF  
Great Britain

*Signed by ALISON DIANE  
SIMONS in my presence  
this 31st day of January  
2002*

*S.M.J. LEACH*  
19 CHURCH STREET  
WOODBIDGE, SUFFOLK

Notary Public





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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Atty. Ref: 36-1008

ATTWATER et al.

Serial No. 09/930,395 (Reissue of U.S. Patent No. 5,940,793)

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1. The undersigned inventors, David J. Attwater, Steven J. Whittaker, Francis J. Scahill and Alison D. Simons (hereinafter "Applicants") hereby declare that for each of them his/her residence, post office address and citizenship are as stated below next to his/her respective name and each believes that Applicants are the original, first and joint inventors of the invention entitled VOICE-OPERATED SERVICES described and claimed in the attached reissue specification filed as U.S. Application No. 09/930,395 on August 16, 2001 and also described and claimed in their original application, U.S. Application No. 08/817,673 filed April 21, 1997 as a national phase filing under 35 U.S.C. §371 of international application no. PCT/GB95/02524 filed October 25, 1995, and the resulting original U.S. Patent No. 5,940,793 (hereinafter "the '793 patent") which issued August 17, 1999; for which priority under 35 U.S.C. §119 was claimed based on European Patent

Application No. 94307843 filed on October 25, 1994; and for which invention a reissue patent is solicited; that they have each reviewed and understand the contents of the attached reissue specification filed as U.S. Application No. 09/930,395, including the claims (i.e., claims 1-49) as amended and added by any amendment(s) specifically referred to in this Declaration; and that each acknowledges the duty to disclose information of which they are aware and which is material to the examination of the application in accordance with 37 CFR §1.56(a).

On information and belief, each of the inventors does not know and does not believe that this invention was ever known or used in the United States before Applicants' invention thereof, or patented or described in any publication in any country before Applicants' invention thereof, or more than one year prior to the original application, or in public use or on sale in the United States more than one year prior to the original application; that this invention had not been patented or made the subject of an inventor's certificate in any country foreign to the United States prior to the date of the original application on an application filed by the inventors or their legal representative or Assignee more than 12 months before their original application.

2. Each of Applicants, believes that, through error, the original '793 patent is wholly or partly inoperative as a legal document by reason of (i) Applicants claiming more or less than they had a right to claim in the patent, and (ii) Applicants' inadvertent failure to disclose possibly pertinent references. All errors being corrected in this reissue application up to the time of filing this Declaration arose without any deceptive intention on the part of Applicants.

3. One error relied upon as a basis for this reissue application is Applicants' failure to request a scope of coverage such as the claims accompanying this reissue application which are necessary to adequately protect Applicants' invention. This error in claiming more or less than Applicants had a right to claim in the '793 patent occurred due to an inadvertent lack of appreciation of the availability of the scope of protection as defined by the amended and additional claims presented with this reissue application.

To correct this error, this reissue application seeks to amend certain of the original claims of the '793 patent and add additional claims. Specifically, claim 16 has been canceled and claims 17 and 18, each depending from claim 16 in the original '793 patent, have been rewritten in independent form. Independent claims 12 and 15 have been amended to delete the recitation of "or destination." Newly added reissue claims 38-45 require, *inter alia*, indicating the destination of a telephone call but do not require indicating the origin of a telephone call. Newly added independent reissue claims 46 and 48 are directed to a method and apparatus which require, *inter alia*, accessing stored information identifying a subset of a set of utterances and restricting recognizing operation to that subset responsive to receipt of signals indicating the origin of spoken words. Unlike claim 12, claims 46 and 48 do not require spoken words received via a telephone line connection. Newly added independent reissue claims 47 and 49 require, *inter alia*, accessing stored information identifying a subset of a set of speakers and restricting recognizing operation to that subset responsive to receipt of signals indicating the origin of spoken words. Unlike claim 12, claims 47 and 49 do not require spoken words being received via a telephone line connection.



4. A further error relied upon as a basis for this reissue application is Applicants' inadvertent failure to properly disclose possibly pertinent references (hereinafter "the REFERENCES") during the prosecution of U.S. Application Serial No. 08/817,673 (hereinafter "the U.S. '673 application") resulting in the U.S. '793 patent. The REFERENCES are hereby identified as follows:

U.S. PATENT DOCUMENTS		
<i>Document No.</i>	<i>Date</i>	<i>Name</i>
4,763,278	08/1988	RAJASEKARAN et al.
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Assignee received a non-unity objection dated December 9, 1997 from the European Patent Office during the prosecution of the EP '749 application. On information and belief, Ms. Hibbert requested payment of the necessary fees for additional searches for separate inventions in response to the objection. Assignee also received an Office Action dated August 7, 1997 from the New Zealand Patent Office during the prosecution of the NZ '296 application.

On information and belief, Ms. Hibbert ended her employment with Assignee on or about February 13, 1998. At or about that same time, Alison D. Simons, one of the named joint inventors of the invention, took over responsibility of prosecuting the U.S. '673, EP '749 and NZ '296 applications on behalf of Assignee in her capacity as a trainee in Assignee's Intellectual Property Department under the supervision of Bob Semos, an in house patent attorney working in the same department. Specifically, Mrs. Simons took over the responsibility of working with Assignee's retained outside U.S. counsel (i.e., the attorneys of record) on the prosecution of the U.S. '673 application on behalf of Assignee under the supervision of Mr. Semos and took over the responsibility of working with Assignee's retained outside New Zealand counsel on the prosecution of the NZ '296 application under the supervision of Bob Semos.

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In response to Ms. Hibbert's requested payment for the necessary fees for additional searches for separate inventions, a Supplementary Search Report dated October 22, 1998 was issued by the European Patent Office in the EP '749 application. The Supplementary Search Report cites all of the references previously cited on the International Search Report plus additional references (hereinafter the "newly cited references"). The Supplementary Search Report was received by Assignee on November 2, 1998 (i.e., before the issuance of the U.S. '793 patent).

An Official Action dated June 4, 1999 was issued from the European Patent Office for the EP '749 application. After reviewing the EP '749 application, the June 4 European Official Action and the International and Supplemental Search reports, Mrs. Simons prepared a response to the European Official Action and filed the same on March 9, 2000. In the March 9 response, those claims which were objected to as not complying with the European Patent Office's unity of invention provisions were canceled. On information and belief, Mrs. Simons did not study in detail the newly cited references of the Supplemental Search Report since those references were cited as being possibly pertinent to claims that

were canceled in the response. The European Patent Office issued a notice under Rule 51(4) of the European Patent Convention (similar to a Notice of Allowance in U.S. practice) on March 20, 2001. In an email dated March 29, 2001 Mrs. Simons reported the notice to David Attwater, another named inventor, and commented on the possibility of filing a divisional application in the European Patent Office for some of those claims canceled during the prosecution of the EP '749 application.

After reviewing the NZ '296 application, the August 7, 1997 New Zealand Official Action and cited references including document WO 93/05605 (hereinafter "WO '605" in or around February 3, 1999 (i.e., before the issuance of the U.S. '793 patent), Mrs. Simons wrote a letter containing a response strategy to Assignee's retained outside New Zealand counsel. A response dated February 4, 1999 was filed in the New Zealand Patent Office by outside New Zealand counsel on the basis on this strategy. On information and belief, WO '605 was cited in the August 7, 1997 New Zealand Office Action as being possibly pertinent to a claim which was deleted in the February 4, 1999 response. The NZ '296 application issued as New Zealand Patent No. 294296 on August 11, 1999. Based on Mrs. Simon's instruction, outside New Zealand counsel filed New Zealand divisional patent application no. 334083 (hereinafter the "NZ '083 application") on February 5, 1999. After receiving and reviewing a non-unity objection dated February 11, 1999 issued by the New Zealand Patent Office in the NZ '083 application, Mrs. Simons instructed retained outside New Zealand counsel to cancel the claim to which WO '605 was cited as being possibly pertinent. The NZ '083 application issued as New Zealand Patent No. 334083 on January 11, 2001.

To the best of Applicants' information and belief, Mrs. Simons was therefore aware of the newly cited references of the Supplemental Search Report issued in the prosecution

of the EP '749 application and WO '605 cited in the prosecution of the NZ '296 application at some point during the pendency of the U.S. '673 application. To the best of Applicants' information and belief, Mrs. Simons was not acutely aware of or did not fully appreciate at that time the duty to disclose known prior art to the U.S. Patent Office and thus did not inform retained outside U.S. counsel about the newly cited references of the Supplemental Search Report or WO '605 during the pendency of the U.S. '673 application. The newly cited references and WO '605 were therefore not provided to the U.S. Patent Office during the pendency of the U.S. '673 application.

On information and belief, Mrs. Simons ended her employment with Assignee on or around April, 2001. Barry Lloyd, an in-house patent attorney in Assignee's Intellectual Property Department, took over the prosecution of the EP '749 application. At the time Mrs. Simons ended her employment with Assignee, the prosecution of the U.S. '673 application had ended (i.e., the U.S. '793 patent and New Zealand Patent Nos. 294296 and 334083 issued prior to Mrs. Simons ending her employment with Assignee).

On information and belief, after reviewing the notice under rule 51(4) of the European Patent Convention, Mr. Lloyd reviewed Assignee's file containing documentation relating to the EP '749 application. During his review of the file, Mr. Lloyd became aware of the existence of the Supplemental Search Report from the European Patent Office and the newly cited references listed therein.

On information and belief, after reviewing the Supplemental Search Report and newly cited references in detail, Mr. Lloyd realized that the newly cited references may be pertinent to claims that were canceled during the prosecution of the EP '749 application and which might form the subject of a European divisional application. Mr. Lloyd then

obtained and reviewed the file containing documentation relating to the U.S. '673 application and determined that the Supplemental Search Report and the newly cited references were not provided to outside U.S. counsel and hence not filed in the U.S. Patent Office during the prosecution of the U.S. '673 application.

On information and belief, Mr. Lloyd discussed the existence of the Supplemental Search Report and the newly cited references in early August, 2001 with Alison Simons who was then and is currently a British patent attorney working in private practice. Mr. Lloyd also discussed the existence of the Supplemental Search Report and the newly cited references with Bob Semos in a separate conversation. On information and belief, Mr. Semos informed Mr. Lloyd that he had no recollection of the prosecution of the U.S. '673 application. After discussing the matter, Mrs. Simons, Mr. Semos and Mr. Lloyd each concluded that the failure to disclose the newly cited references to the U.S. Patent Office during prosecution of the U.S. '673 application was an inadvertent error.

On information and belief, soon after or about the same time as discussing the existence of the Supplemental Search Report and the newly cited references with Alison Simons and Bob Semos, Mr. Lloyd obtained the file containing documentation relating to the NZ '296 and NZ '083 applications. Upon reviewing the contents of these files, Mr. Lloyd first became aware of the existence of WO '605. Mr. Lloyd discussed the existence of WO '605 with Alison Simons and Bob Semos in separate conversations. Mrs. Simons, Mr. Semos and Mr. Lloyd each concluded that the failure to disclose WO '605 to the U.S. Patent Office during the prosecution of the U.S. '673 application was an inadvertent error.

5. The Applicants now seeks to correct the errors noted in ¶¶3 and 4 above by requesting that the '793 patent be reissued. Accordingly, Applicants have filed the instant

reissue application in order to properly claim what they have a right to claim and to properly disclose the REFERENCES inadvertently not disclosed during prosecution of the '673 application.

Applicants hereby appoint Nixon & Vanderhye, P.C., 1100 North Glebe Road, 8th Floor, Arlington, Virginia 22201-4714, telephone number (703) 816-4000, facsimile number (703) 816-4100, and the following attorneys thereof: Arthur R. Crawford, 25327; Larry S. Nixon, 25640; James T. Hosmer, 30184; Robert W. Faris, 31352; Richard G. Besha, 22770; Mark E. Nusbaum, 32348; Michael J. Keenan, 32106; Bryan H. Davidson, 30251; Stanley C. Spooner, 27393; Leonard C. Mitchard, 29009; Duane M. Byers, 33363; Jeffry H. Nelson, 30481; John R. Lastova, 33149; H. Warren Burnam, Jr. 29366; Thomas E. Byrne, 32205; Mary J. Wilson, 32955; J. Scott Davidson, 33489; Alan M. Kagen, 36178; Robert A. Molan, 29834; B. J. Sadoff, 36663; James D. Berquist, 34776; Updeep S. Gill, 37334; Michael J. Shea, 34725; Donald L. Jackson, 41090; Michelle N. Lester, 32331; Frank P. Presta, 19828; Joseph S. Presta, 35329; Joseph A. Rhoa, 37515; Raymond Y. Mah, 41426; Chris Comuntzis, 31,097 as my attorneys in the above-entitled application, to prosecute this application, to make alterations and amendments therein, and to transact all business in the Patent and Trademark Office connected therewith.

All correspondence regarding the above-identified application is to be sent to:

**NIXON & VANDERHYE P.C.**  
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Applicants hereby declare further that all statements made herein of their own knowledge are true and that all statements made on information and belief are believed to



be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

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